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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/406,001 09/24/99 HIATT, JR.

A HTT-9901

WM02/0830
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EXAMINER

CRAVER, C

ART UNIT

PAPER NUMBER

2681

DATE MAILED: 08/30/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/406,001

Applicant(s)

Hiatt, Jr.

Examiner

Charles Craver

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 12, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: ☐ approved ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☒ Interview Summary (PTO-413) Paper No(s). 11
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 1-12-01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/406,001 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Interview

2. In response to the interview between the applicant and examiner on 4-25-01, the last office action has been vacated. A new office action follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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5. Claim 1 recites “a computer connected to the wireline communication network, the computer containing an address software that is capable of extracting a plurality of addresses in an address database and sending the plurality of addresses to the portable wireless electronic device, storing the plurality of addresses in the address database of the portable wireless electronic device...”. Said recitation strongly implies that the storage of the data at the wireless device is performed by the software at the computer, even though said storage would be inherently performed by hardware and software at the user portable device. A thorough reading of applicant’s disclosure has only shown that it is in fact the wireless device which performs the storage, see spec. page 6 lines 20-22.

Claim Objections

6. Claim 12 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 12 recites a transfer of information from a first device to a second device, which is already recited in limitation (d) of the claim from which it depends.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-14, 16 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe et al, of record, in view of "Import Personal Address Book (PAB) to Outlook 97" by Grant Miller.

Regarding claim 1,

Pepe discloses a system for transferring data comprising:

a portable wireless device (30, col 1 lines 36-41)

a wireless communication system (54) capable of establishing a wireless communication link with the device

a wireline network (49) connected to the wireless network (see FIG 4)

a computer (22, see FIG 1) connected to the wireline network, the computer capable of sending data to the wireless device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), the computer inherently using software. Further, since the data may be in email format (col 3 lines 48-56), it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer is not a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the portable device stores the received addresses in its address database.

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Miller discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (lines 1-15). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database. For a more detailed explanation of said process, see "User Profiles and Information Services" and "How to Copy the PAB to Another Computer", Microsoft publications Q162203 and Q169709.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

Regarding claim 2,

Pepe discloses that said wireless device is a cellular device (col 1 lines 36-41).

Regarding claim 3,

As shown above, Pepe discloses applicants invention of claim 1. However, Pepe does not specifically disclose that said network operates under a digital PCS wide area network protocol. However, such a feature was well known in the art at the time of the invention, and as such the

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examiner takes Official Notice of such a feature. It would have been obvious, noting Pepe's disclosure that the user may comprise a cellular terminal, that such a memory transfer method may be applied to a PCS wide area network, as it would allow the invention of Pepe to operate on new communication systems and standards.

Regarding claim 4,

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe does not specifically recite that said network may operate according to a hypertext protocol. However, given that Pepe does disclose thus use of internet and email protocol (col 5 lines 5-13), it would have been obvious to one skilled in the art at the time of the invention to utilize HTTP as it is a common internet protocol for transferring data.

Regarding claim 5,

Pepe teaches that the invention may utilize the internet (col 23 lines 40-46) and uses email as a messaging standard (col 3 lines 48-56, col 11 lines 3-6).

Regarding claims 6-9,

Pepe discloses a PDA which would inherently contain a program for transferring the data. As for claims 7-9, since Pepe teaches a PDA which may send email to the computer (col 10 line 63-col 11 line 6), a situation in which a PDA user sends an email using said software requesting, for example, a telephone number, file, or selected addresses would read on claims 7-9.

Regarding claims 10 and 12,

Pepe discloses a method for transferring information comprising

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at a first electronic device (computer 22, see FIG 1) connected to a combined wireline (54) and wireless (49) network (FIG 4), setting up a communication path between it and a second device (30) connected to said networks (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using transfer software to do so and using or entering an address of said second device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), and sending said data, which may be in email format (col 3 lines 48-56); given such a format, it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer and device are not specifically a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the data is moved from the first address book to the second.

Miller discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (lines 1-17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

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Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

Regarding claim 11,

Pepe discloses that the communication can be bi-directional (see FIG 1).

Regarding claims 13 and 14,

Miller disclose that said addresses may be in a file (lines 1-10), and as such selection of a field in the file would further have been obvious to one of ordinary skill in the art as it would not part from the scope of the teachings of Pepe in view of Miller.

Regarding claim 16,

Since the second device of the invention of Pepe is in part a cellular telephone (col 5 lines 5-30), it is inherent that it would be identified by its telephone number when a data request message is to be sent to it via said messaging protocols.

Regarding claim 18,

Pepe discloses a method for transferring information from a computer (22, see FIG 1) inherently using a program, comprising

at said first electronic device, connected to a network (FIG 4), setting up a communication path between it and a second device (30) connected to said network (col 5 lines 14-40 see FIG 3), inherently comprising a step of selecting or using/displaying transfer software to do so and using

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or entering or requesting an address of said second device (col 5 lines 31-54, col 6 lines 28-35, col 23 lines 35-63), and sending said data, which may be in email format (col 3 lines 48-56); given such a format, it is assumed that the data may comprise any information a user wishes to transfer, including but not limited to text, files, or a plurality of addresses. Lastly, the computer and device are not specifically a part of the wireline or wireless networks (see FIGS 1 and 4).

Pepe does not specifically disclose that the portable device and the computer have address databases, and that the data is moved from the first address book to the second and stored there.

Miller discloses an email program well known in the art at the time of the invention and used in both wireline computers (i.e. the computer of claim 1) and notebook computers (i.e. the portable device) which comprises an address database, and wherein a user may copy information from a file (receivable from e.g. an email) and insert it into their address database (lines 1-17). As such, such software may be utilized by the system of Pepe; for example, the computer may send an address book file via email through the network of Pepe to the wireless user, who may then insert the address book including the addresses therein into their email program, inherently storing said addresses in said address database.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to add such a feature to the email network of Pepe, as it would allow the use of popular email software used by a very large percentage of world email users on said portable device, for example Microsoft Outlook.

Regarding claims 19 and 20,

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Miller discloses that said addresses may be in a file (lines 1-10), and as such selection of a field in the file would further have been obvious to one of ordinary skill in the art as it would not part from the scope of the teachings of Pepe in view of Miller.

9. Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pepe in view of Miller as applied to claim 10 above, and further in view of Günlük, of record.

While disclosing all of the limitations set forth in claim 1 as shown above, Pepe in view of Miller does not specifically recite that said network may operate according to a hypertext (i.e. internet) protocol or an electronic mail protocol such that a URL or E-mail address is entered rather than a phone number to contact the wireless device.

Günlük discloses that it is useful in a wireless messaging system using, for example, SMS, to allow interoperability, that is, to operate the network such that SMS and other such messaging protocols may be translated into other protocols for messaging interoperability, said other protocols including electronic mail and TCP/IP (i.e. hypertext) (see FIG 2, col 3 lines 55-67). Therefore, it would have been obvious to one skilled in the art to add such a feature to Pepe in view of Miller as it would offer a higher performance message routing method, and thus allow better access to the information present in the wireless device.

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Response to Arguments

10. Applicant's arguments with respect to claims 1, 10 and 18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

“Multimedia and Portability Advance in ‘97” and “A Review of Office 97 Professional” disclose that Microsoft Outlook 97 (referred to in the rejections above) was available to the public prior to applicant’s filing date.

“OL97: Microsoft Outlook Version Information” details release versions of OL97.

“Yahoo! Help-Import/Export” details steps to transfer via the internet an OL97 address book to and from a server.

12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

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(703) 872-9314 (for informal or draft communications, please label "PROPOSED" or "DRAFT")


Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, sixth floor (receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Craver whose telephone number is (703) 305-3965.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost, can be reached on (703) 305-4778.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

CC
C. Craver
August 1, 2001


TRACY LEGREE
PRIMARY EXAMINER